

II. REMARKS

As an initial matter, the Examiner contends that a certified copy of Applicant's foreign priority document, namely, Japanese Patent Application No. 2004-025293 of February 2, 2004 , has not been received (Office Action, mailed June 24, 2009, at 2, lines 12-17). Applicant's attorney, Wesley Ashton, contacted the USPTO PCT Helpdesk (571-272-4300) and the PCT Helpdesk personnel informed the attorney that a copy of Applicant's foreign priority document, Japanese Patent Application No. 2004-025293 filed February 2, 2004, has been downloaded from the International Bureau and scanned into the USPTO database. Therefore, Applicant respectfully requests that the Examiner check again for the copies of the certified copies of Japanese Patent Application No. 2004-025293 because Applicant believes USPTO PCT Helpdesk personnel have retrieved a copy from the International Bureau. Applicant also requests that the Examiner acknowledge receipt of the document from the International Bureau.

Claim 9 has been cancelled without prejudice, and claims 1-3, 7 and 8 have been amended. Specifically, claims 1-3, 7 and 8 have been amended to replace "first virtual community" with --virtual community--, which has no further limiting effect on the scope of the claims. Independent claims 1 and 7 have been further amended to recite "a control means for issuing, for the purpose of mounting a virtual tag community on a website set up by a registered second user, a community tag" and "wherein the virtual tag community mounted on the website is only a portion of the virtual community corresponding to the address of the second registered user" as supported on page 5, lines 7-22, page 6, lines 2-9, page 7, lines 14-21, and Figures 1 and 2 of Applicant's disclosure as originally filed. Independent claim 8 has been further amended to recite "issuing a community tag, by the community providing server,

for a second user who accesses the community providing server and registers with the virtual community in order to mount a virtual tag community on a website set up by a registered third user” and “wherein the virtual tag community mounted on the website is only a portion of the virtual community corresponding to the address of a third registered user” as supported on page 5, lines 7-22, page 6, lines 2-9, page 7, lines 14-21, and Figures 1 and 2 of Applicant’s disclosure as originally filed.

New claim 11 depends upon claim 7, and additionally recites

“wherein the user terminal is a first user terminal used by the first user to access the virtual tag community mounted on the website used by the registered second user, and the virtual community system further comprises at least one second user terminal connected to the virtual community providing server, the first user terminal and the user website server via the network, wherein the registered second user uses the second user terminal to access the virtual tag community mounted on the website used by the registered second user,”

as supported on page 9, line 6, to page 10, line 28, of Applicant’s specification as originally filed. New claim 12 depends upon claim 11, and additionally recites “wherein first user accesses the virtual tag community mounted on the website used by the registered second user without having to access another website to use content of the virtual community” as supported on page 14, lines 1-15, of Applicant’s specification as originally filed.

The present amendment adds no new matter to the above-captioned application.

A. The Invention

The present application pertains broadly to a community providing server providing a virtual community for a user who has a user terminal connected to the server via a network, and to a virtual community system providing a virtual community for a user, and to a virtual community providing method, and to a virtual community providing program, such as relates

to a virtual community that may be offered, for example, via the Internet. In accordance with an apparatus embodiment of the present invention, a community providing server is provided that includes features recited by independent claim 1. In accordance with another apparatus embodiment of the present invention, a virtual community system is provided that includes features recited by independent claim 7. In accordance with a method embodiment of the present invention, a virtual community providing method is provided that includes steps recited by independent claim 8. Various other embodiments, in accordance with the present invention, are recited by the dependent claims.

An advantage provided by the various embodiments of the present invention is that a virtual community system, server, method, and/or program is provided that effectuates a virtual community that is more convenient to use and that facilitates effective advertising.

B. The Rejections

Claim 9 stands rejected under 35 U.S.C. § 101 for allegedly failing to recite statutory subject matter.

Claims 1, 2 and 7-10 stand rejected under 35 U.S.C. § 103 as allegedly unpatentable over Matsuda (U.S. Patent Application Publication No. US 2002/0054094 A1, hereafter the “Matsuda Publication”) in view of Parry (U.S. Patent Application Publication No. US 2002/0178186, hereafter the “Parry Publication”). Claim 3 stands rejected under 35 U.S.C. § 103 as allegedly unpatentable over the Matsuda Publication in view of the Parry Publication, and further in view of DuVal (U.S. Patent 5,818,836, hereafter the “DuVal Patent”). Claim 4 stands rejected under 35 U.S.C. § 103 as allegedly unpatentable over the Matsuda Publication

in view of the Parry Publication, and further in view of Olivier (U.S. Patent 6,480,885, hereafter the “Olivier Patent”).

Applicant respectfully traverses the Examiner’s rejections and requests reconsideration of the above-captioned application for the following reasons.

C. Applicant’s Arguments

The Examiner objects to claims 1-4 and 7-10 on the grounds that the phrases “first virtual community” is unclear. In view of the present amendment, these claims now recite a “virtual community,” which is clear.

The Examiner objects to claims 1, 7, 8 and 9 on the grounds that “a portion of the first virtual community” is not clear and is not supported by Applicant’s original specification. Applicant disagrees. According to Applicant’s original specification, at 5, lines 7-13, and as shown by Applicant’s original FIG. 1, a community providing server (10) stores the data providing the entire virtual community. Furthermore, an HTML tag, referred to as a “community tag,” is used so that contents of the virtual community may be mounted on a website of each user so that users participating in the virtual community may communicate with each other without having to access a specified homepage (Applicant’s original specification, at 5, lines 18-26). The contents of the virtual community that are tagged for this purpose are referred to as the “tag community” (Applicant’s original specification, at 5, lines 18-22). As evident from Applicant’s disclosure (Applicant’s original specification, at 5, lines 18-22), the “tag community” includes only a portion of the contents of the virtual community. This fact is further evident from Figure 2 and page 6, lines 2-9, of Applicant’s original disclosure, which describes a database (DB 11), which includes all of the data

corresponding to the virtual community, and a database (DB 14), which is a component of database (DB 11), and which stores contents of a specified website for the virtual community and contents data corresponding to a tag community shown on terminal (20).

Consequently, each user may have his own tag community, which shows only a portion of the whole map of the virtual community corresponding to the user's own address within the community (Applicant's original disclosure, at 10, lines 22-28, and at 14, lines 1-15, and FIG. 7). Therefore, it would be immediately evident to a person of ordinary skill in the art that, according to Applicant's original disclosure, the "virtual tag community" pertains to a subset of the contents of the "virtual community," which has been tagged with an HTML tag (i.e., a community tag) for display by a particular website.

As described by Applicant's specification, at 5, lines 18-22, at 10, lines 22-28, and at 14, lines 1-15, and by FIG. 7, the "tag community" includes only a portion of the contents of the virtual community. This is self-evident from the fact that Applicant's invention permits users at different terminals to display different tag communities, and to move from one tag community to another (Applicant's original specification, at 15, line 14, to at 16, line 2, and at 17, lines 4-6, and FIGs. 7 and 9).

If each of the tag communities included all of the contents of the virtual community (which is not the case according to the present invention), then there would be no reason to visit tag communities displayed on different websites because they would all be the same. As discussed above, the present invention allows each user to create his own tag community and to display it on his own website using only a portion of the entire virtual community.

Therefore, it is clear that Applicant's original disclosure provides support for the limitation wherein "the virtual tag community mounted on the website is only a portion of the

virtual community corresponding to the address of the second registered user” as claimed because users may access other tag communities mounted on other websites. If all of the users mounted the same tag community on their websites, there would be no reason to move to a prescribed user’s website to visit his tag community as described on page 17, lines 4-7, of Applicant’s original specification because all users would have the same “tag community” mounted on their websites. As discussed above, this is not the case because different users may mount different tag communities on their websites.

For all of the above reasons, a person of ordinary skill in the art would recognize that Applicant’s original disclosure supports the limitation wherein “the virtual tag community mounted on the website is only a portion of the virtual community corresponding to the address of the second registered user” because each tag community is a subset (i.e., a portion comprising a fraction of the whole) of the whole content of the virtual community. In other words, each tag community is made up of a portion of the virtual community that is tagged and mounted on a user’s website.

i. The Section 103 Rejections

A prima facie case of obviousness requires a showing that the scope and content of the prior art teaches each and every element of the claimed invention, and that the prior art provides some teaching, suggestion or motivation, or other legitimate reason, for combining the references in the manner claimed. KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 1739-41 (2007); In re Oetiker, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). In this case, the Examiner has failed to establish a prima facie case of obviousness against Applicant’s claimed invention because the combination of the Matsuda Publication, the Parry Publication, the DuVal Patent,

and the Olivier Patent, fails to teach, or suggest, each and every limitation recited by claims 1-4, 7, 8 and 10-12.

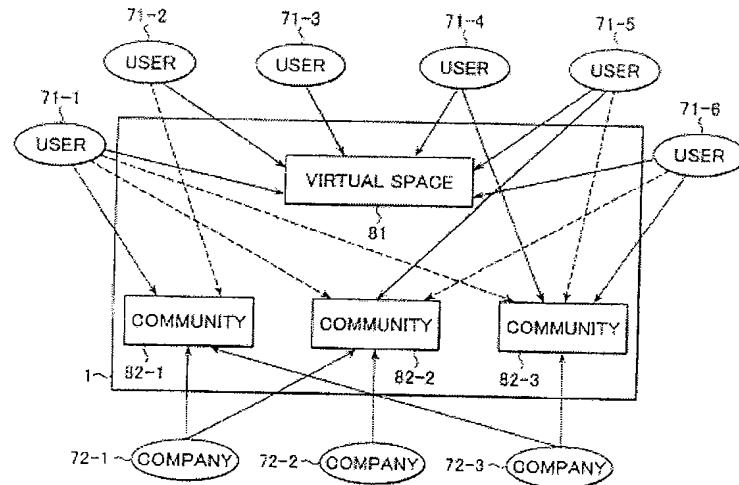
iii. The Matsuda Publication

The Matsuda Publication discloses an “information processing apparatus, information processing method, service providing system, and computer program thereof,” wherein the invention allows the exchange of community cards within a virtual space, and a display screen shown on the display section of the user terminal device is composed of a virtual space display for displaying three-dimensional objects in a virtual space, and a list window of belongings displayed by the user's own community cards (See Abstract of the Matsuda Publication, and Figures 7 and 9). The Matsuda Publication discloses that the user can move freely within the virtual space while referring to the virtual space display, and when conversing with other users within the virtual space and when the user wants to let another user participate in the community the user himself belongs to, the user can present community cards corresponding to the avatar, to a user for newly participating in the community, by drag-and-drop of any of the community cards on the avatar (See Abstract of the Matsuda Publication).

A person of ordinary skill in the art would instantly realize that the Matsuda Publication discloses a virtual community (See, e.g., Matsuda Publication, Figure 5, reproduced below for the Examiner's convenience). As admitted by the Examiner (Office Action, dated June 24, 2009, at 7, lines 11-16; at 12, lines 1-3), the Matsuda Publication does not teach, or suggest, (i) “a control means for issuing, for the purpose of mounting a virtual tag community on a website set up by a registered second user, a community tag that is to be

inserted in HTML data constituting the website" as recited by independent claims 1 and 7, (ii)
"issuing a community tag, by the community providing server, for a second user who
accesses the community providing server and registers with the virtual community in order to
mount a virtual tag community on a website set up by a registered third user" as recited by

FIG.5



independent claim 8, and (iii)

"wherein the virtual tag community mounted on the website is only
a portion of the virtual community corresponding to the address of the second
registered user,"

as recited by claims 1 and 7, and (iv)

"wherein the virtual tag community mounted on the website is only
a portion of the virtual community corresponding to the address of a third
registered user,

as recited by claim 8.

As further admitted by the Examiner (Office Action, dated June 24, 2009, at 13, lines 8-9; and at 14, lines 3-11), the Matsuda Publication does not teach, or suggest, (v)

"when a fifth user who has not logged into the virtual community
accesses the website mounting the virtual tag community, the control means

performs control to show a specific character that indicates the fifth user is not in a logged-in state in the virtual tag community”

as recited by claim 3, and (v)

“the user management information database stores an address of the website of the third user owning the website mounting the virtual tag community among the registered users, and the control means provides information of the address of the website for a fourth user via the virtual tag community”

as recited by claim 4.

In sum, while the Matsuda Publication may disclose a common virtual community, it does not teach, or suggest, a “virtual tag community,” which is only a portion of the virtual community. The Matsuda Publication also does not teach, or suggest, the subject matter of new claims 11 and 12.

iv. The Parry Publication

The Parry Publication discloses a “remote URL munging business method” wherein the business method provides a remotely hosted service by an application service provider (ASP) wherein the hosted service is seamlessly integrated into a customer document at a user location (See Abstract of the Parry Publication). According to the Parry Publication, a system for providing the business method includes a combination of novel JavaScript technology and URL munging, wherein, for example, an administrative interface may facilitate the insertion of a line of static JavaScript code into a customer's Web page (See Abstract of the Parry Publication). The Parry Publication discloses that the code may interpret a munged URL and pass the munged URL to an ASP server, and the ASP server may extract session variables that were encoded in the munged URL (See Abstract of the Parry Publication). The Parry Publication discloses that the ASP server may generate a

dynamic JavaScript program that displays the hosted service, e.g., a hosted site search engine, and that the hosted service may thereby be written directly into the customer's Web page so that the Web user is not aware that the service is hosted remotely (See Abstract of the Parry Publication). Thus, a person of ordinary skill in the art would instantly realize that the Parry Publication discloses a site search engine that is mounted on a customer's website (See, e.g., Parry Publication, ¶¶ [0098] to [0100]).

As admitted by the Examiner (Office Action, dated June 24, 2009, at 13, lines 8-9; and at 14, lines 3-11), the Parry Publication does not teach, or even suggest, (i)

“when a fifth user who has not logged into the virtual community accesses the website mounting the virtual tag community, the control means performs control to show a specific character that indicates the fifth user is not in a logged-in state in the virtual tag community”

as recited by claim 3, and (ii)

“the user management information database stores an address of the website of the third user owning the website mounting the virtual tag community among the registered users, and the control means provides information of the address of the website for a fourth user via the virtual tag community”

as recited by claim 4. However, these are not the only deficiencies in the disclosure of the Parry Publication, which also does not teach or suggest (iii)

“wherein the virtual tag community mounted on the website is only a portion of the virtual community corresponding to the address of the second registered user,”

as recited by claims 1 and 7, and (iv)

“wherein the virtual tag community mounted on the website is only a portion of the virtual community corresponding to the address of a third registered user,”

as recited by claim 8.

The Parry Publication is limited to disclosing a site search engine that is mounted on a customer's website (Parry Publication, ¶¶ [0098]-[0100]). The Parry Publication does not teach, or suggest, a virtual tag community mounted on a website, wherein the virtual tag community is only a portion of the virtual community. Furthermore, the Parry Publication does not teach, or suggest, mounting the virtual tag community corresponding to the address of a third user who owns the website.

The Parry Publication also does not teach, or suggest, the subject matter of new claims 11 and 12.

v. **The DuVal Patent**

The DuVal Patent discloses a “method and apparatus for anonymous voice communication using an online data service,” which pertains to an anonymous telephone communication system that includes an anonymous voice system, which can establish an anonymous telephone communication through a circuit switched network (CSN), (See Abstract of the DuVal Patent). The DuVal Patent discloses that, when in operation, (a) two parties place separate telephone calls to the anonymous voice system through the CSN, then (b) the parties enter matchcodes through their telephone keypads, (c) the anonymous voice system compares the matchcodes entered by the parties and connects the telephone calls if the matchcodes match (See Abstract of the DuVal Patent). The system disclosed by DuVal may include an on-line data service that establishes electronic communication between the parties through corresponding data terminals, and the data terminals may have resident anonymous voice input commands that can be selected by the parties (See Abstract of the DuVal Patent). According to the DuVal Patent, the on-line data service transmits a connect command to the

anonymous voice system that dials the two parties, or waits for the parties to dial the system, and then connects the parties, and the anonymous voice system sends a disconnect command to the on-line data service when the parties hang up (See Abstract of the DuVal Patent). The disconnect command can be used by the online service to bill the parties for using the anonymous voice service, and the system also stores a couple record during the first anonymous call recording the matchcode and the telephone numbers of both parties so that, subsequently, either party may initiate an anonymous call to the other party without prior coordination (See Abstract of the DuVal Patent).

However, the DuVal Patent does not teach, or suggest, “when a fifth user who has not logged into the virtual community accesses the website mounting the virtual tag community, the control means performs control to show a specific character that indicates the fifth user is not in a logged-in state in the virtual tag community” as recited by claim 3. The Duval Patent discloses an icon (108), as shown in Figure 4 (reproduced below for the Examiner’s convenience), for initiating an anonymous phone call (DuVal Patent, col. 9, lines 1-7). A person of ordinary skill in the art would instantly realize that the icon (108) disclosed by the DuVal Patent does not pertain to “a specific character that indicates the fifth user is not in a logged-in state in the virtual tag community” as recited in claim 3 because icon (108) is used to initiate a telephone call. Icon (108) does not indicate whether or not the user is presently logged in to the anonymous telephone communication system because the caller has no way of knowing if the callee is already logged into the system and is on a call with a third party using the system.

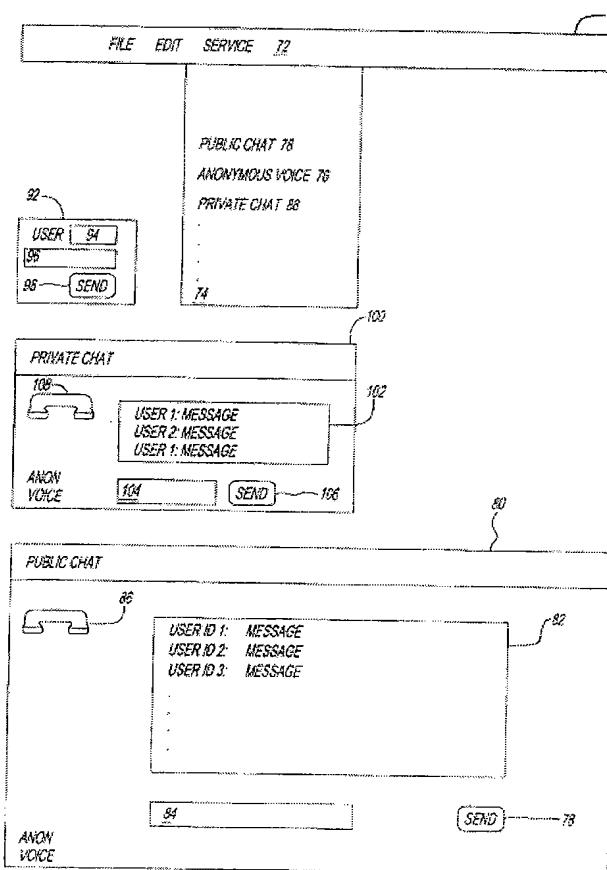


FIG. 4

For all of the above reasons, the DuVal Patent does not teach, or suggest, “the control means performs control to show a specific character that indicates the fifth user is not in a logged-in state in the virtual tag community” as recited by claim 3.

vi. The Olivier Patent

The Olivier Patent discloses “dynamically matching users for group communications based on a threshold degree of matching of sender and recipient predetermined acceptance criteria,” wherein the method enables users to exchange group electronic mail by establishing individual profiles and criteria, for determining personalized subsets within a group (See

Abstract of the Olivier Patent). According to the Olivier Patent, users establish subscriptions to an electronic mailing list by specifying user profile data and acceptance criteria data to screen other users, and when a user subscribes a web server establishes, and stores, an individualized recipient list including each matching subscriber and their degree of one-way or mutual match with the user (See Abstract of the Olivier Patent). The Olivier Patent discloses that when the user then sends a message to the mailing list, an email server retrieves 100% her matches and then optionally filters her recipient list down to a message distribution list using each recipient's message criteria, and the message is then distributed to matching users (See Abstract of the Olivier Patent). Additionally, email archives and information contributions from users are stored in a database (See Abstract of the Olivier Patent).

According to the Olivier Patent, the web server creates an individualized set of web pages for a user from the database, containing contributions only from users in his recipient list (See Abstract of the Olivier Patent). In other embodiments disclosed by the Olivier Patent, users apply one-way or mutual criteria matching and message profile criteria to other group forums, such as web-based discussion boards, chat, online clubs, USENET newsgroups, voicemail, instant messaging, web browsing side channel communities, and online gaming rendezvous (See Abstract of the Olivier Patent).

vii. Summary of the Disclosures

The combination of the Matsuda Publication, the Parry Publication, the DuVal Patent, and the Olivier Patent does not teach, or suggest, (i)

“wherein the virtual tag community mounted on the website is only a portion of the virtual community corresponding to the address of the second registered user,”

as recited by claims 1 and 7, and (ii)

“wherein the virtual tag community mounted on the website is only a portion of the virtual community corresponding to the address of a third registered user,

as recited by claim 8, and (iii) “the control means performs control to show a specific character that indicates the fifth user is not in a logged-in state in the virtual tag community” as recited by claim 3. The combination of the Matsuda Publication, the Parry Publication, the DuVal Patent, and the Olivier Patent does not teach, or suggest, the subject matter recited by new claims 11 and 12.

For all of the above reasons, the Examiner has failed to establish a prima facie case of obviousness against claims 1-4, 7, 8 and 10-12.

ix. No Legitimate Reason to Justify the Combination, and No Reasonable Expectation of Success Even if the Combination Were Made

A proper rejection under Section 103 requires showing (1) that a person of ordinary skill in the art would have had a legitimate reason to attempt to make the composition or device, or to carry out the claimed process, and (2) that the person of ordinary skill in the art would have had a reasonable expectation of success in doing so. PharmaStem Therapeutics, Inc. v. ViaCell, Inc., 491 F.3d 1342, 1360 (Fed. Cir. 2007). In this case, the Examiner has failed to establish a prima facie case of obviousness against Applicant’s claimed invention because the Examiner has not established a legitimate reason to combine the disclosures of the Matsuda Publication, the Parry Publication, the DuVal Patent, and the Olivier Patent, and the Examiner has failed to demonstrate that a person of ordinary skill in the art would have had a

reasonable expectation of success of arriving at Applicant's claimed invention even if the combination was made.

Specifically, the combination of the Matsuda Publication, the Parry Publication, the DuVal Patent, and the Olivier Patent falls short of Applicant's claimed invention for the reasons discussed above; therefore, the Examiner has failed to demonstrate a reasonable expectation of success even if the combination asserted by the Examiner is made. For the same reasons, the Examiner has failed to establish a legitimate reason for making the combination.

According to the present invention, the registered users, who access the website mounting the virtual tag community (which is only a portion of the virtual community), may communicate virtually and mutually in the virtual tag community. This means of communication within the virtual tag community is possible because the virtual tag community is only a section or portion of the entire virtual community and because the virtual tag community corresponds to the address of the user who owns the website where the virtual tag community is mounted. On the other hand, because the Parry Publication discloses mounting only a site search engine on a website, persons of skill in the art would realize that the Parry Publication does not disclose that users, who access the website, may communicate mutually at the website. A person of ordinary skill in the art would immediately realize this shortcoming with respect to the subject matter disclosed by the Parry Publication because a site search engine is not used as a communication tool by those accessing a website.

As discussed above, the Matsuda Publication pertains to a virtual community and the Parry Publication discloses a site search engine mounted on a customer's website. Thus,

even if the disclosures of the Matsuda Publication and the Parry Publication were combined, a person of ordinary skill in the art would have no guidance regarding how to mount a virtual tag community on a customer's website (i.e., the person of ordinary skill in the art would have no guidance regarding how to mount only a portion of the virtual community on the customer's website). On the contrary, the combination of the Matsuda Publication and the Parry Publication would be limited to providing guidance regarding how to mount a virtual community, and not a virtual tag community, on a website. Therefore, the Examiner has failed to demonstrate that a person of ordinary skill in the art would have had a reasonable expectation of success of arriving at Applicant's claimed invention even if the combination of the Matsuda Publication, the Parry Publication, the DuVal Patent, and the Olivier Patent was made.

For all of the above reasons, the Examiner has failed to establish a prima facie case of obviousness against claims 1-4, 7, 8, 9 and 10-12.

IV. CONCLUSION

The Examiner has failed to establish a prima facie case of obviousness against claims 1-4, 7, 8 and 10-12 because the combination of the Matsuda Publication, the Parry Publication, the DuVal Patent, and the Olivier Patent does not teach, or suggest, (i)

"wherein the virtual tag community mounted on the website is only a portion of the virtual community corresponding to the address of the second registered user,"

as recited by claims 1 and 7, and (ii)

"wherein the virtual tag community mounted on the website is only a portion of the virtual community corresponding to the address of a third registered user,

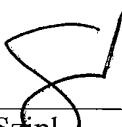
as recited by claim 8, and (iii) "the control means performs control to show a specific character that indicates the fifth user is not in a logged-in state in the virtual tag community" as recited by claim 3, and because the Examiner has not established a legitimate reason to make the combination, and because the Examiner has not demonstrated that a person of ordinary skill in the art would have had a reasonable expectation of success of arriving at the claimed invention even if the combination was made.

For all of the above reasons, claims 1-4, 7, 8 and 10-12 are in condition for allowance, and a prompt notice of allowance is earnestly solicited.

The below-signed attorney for Applicant welcomes any questions.

Respectfully submitted,

GRIFFIN & SZIPPL, P.C.



Joerg-Uwe Szipl
Registration No. 31,799

GRIFFIN & SZIPPL, P.C.
Suite PH-1
2300 Ninth Street, South
Arlington, VA 22204

Telephone: (703) 979-5700
Facsimile: (703) 979-7429
Email: GandS@szipl.com
Customer No.: 24203